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FIRST NAMED INVENTOR FILING DATE ATTORNEY DOCKET NO. APPLICATION NO. 09/428,692 10/28/99 CARR D 18475-016 **EXAMINER** HM22/0730 DAVID B BERNSTEIN LANDSMAN.R **ART UNIT** PAPER NUMBER MINTZ LEVIN COHN FERRIS GLOVSKY AND POPEO PC ONE FINANCIAL CENTER 1647 BOSTON MA 02111 DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

07/30/01

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مز		Application No.	Applicant(s)	
		09/428,692	CARR ET AL.	
	Office Action Summary	Examiner	Art Unit	
·		Robert Landsman	1647	
The MAILING DATE of this communication appears on the cover sheet with the correspondence address Peri df r Reply				
A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION. - Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication. - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely. - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication. - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). - Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).				
1)🖂	Responsive to communication(s) filed on 20 M	farch 2001 .		
2a) <u></u>		s action is non-final.		
3)	3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i> , 1935 C.D. 11, 453 O.G. 213.			
Disposition of Claims				
4)⊠ Claim(s) <u>1-17</u> is/are pending in the application.				
4a) Of the above claim(s) is/are withdrawn from consideration.				
5) Claim(s) is/are allowed.				
6) Claim(s) is/are rejected.				
7)	7) Claim(s) is/are objected to.			
8) Claim(s) 1-17 are subject to restriction and/or election requirement.				
Application Papers				
9)☐ The specification is objected to by the Examiner.				
10) The drawing(s) filed on is/are: a) □ accepted or b) □ objected to by the Examiner.				
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).				
11) ☐ The proposed drawing correction filed on is: a) ☐ approved b) ☐ disapproved by the Examiner.				
If approved, corrected drawings are required in reply to this Office action.				
12)☐ The oath or declaration is objected to by the Examiner.				
Pri rity under 35 U.S.C. §§ 119 and 120				
13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).				
a) ☐ All b) ☐ Some * c) ☐ None of:				
1. Certified copies of the priority documents have been received.				
2. Certified copies of the priority documents have been received in Application No.				
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)). * See the attached detailed Office action for a list of the certified copies not received. 				
14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).				
a) ☐ The translation of the foreign language provisional application has been received. 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.				
Attachment(s)				
2) 🔲 Notice	of References Cited (PTO-892) of Draftsperson's Patent Drawing Review (PTO-948) ation Disclosure Statement(s) (PTO-1449) Paper No(s)	5) Notice of Informal Pa	(PTO-413) Paper No(s) atent Application (PTO-152)	

² Application/Control Number: 09/428,692

Art Unit: 1647

DETAILED ACTION

1. Election/Restriction

A. Applicants were sent a restriction plus an election of species on 12/14/00 (Paper No. 5). In the response of 3/20/01, Applicants elected Group 1, claims 1-17. However, Applicants were also required to elect a species of chimeric peptide in which they were to elect one nociceptive receptor binding moiety (one of SEQ ID NO:21-41) and one opioid (either mu, kappa, or detla) receptor binding moiety (SEQ ID NO1-20 and 44). Applicants elected the chimeric peptide comprising a mu opioid receptor binding moiety, but failed to elect a nociceptive receptor binding moiety and mu opioid receptor binding moiety as required by the election of species. However, in light of the fact that each of these SEQ ID NOs is independent, and, therefore, patentably distinct, and one is not deemed obvious over the other, the species election has been withdrawn and restriction to one of the following inventions is required under 35 U.S.C. 121:

Claims 1-17 recite 21 distinct nociceptive receptor binding moieties of SEQ ID NO:21-41 and 11 mu opioid receptor binding moieties (SEQ ID NO:1-11). Therefore, the total combination of chimeric peptides which can be made using one nociceptive receptor binding moiety and one mu opioid receptor binding moiety, is 231 (11x21).

These 231 inventions are distinct, each from each other because Inventions 1-231 are independent and are products which possess characteristic differences in structure and function and each has an independent utility that is distinct for each invention which cannot be exchanged.

Therefore, Applicants are required to elect one nociceptive receptor binding moiety of SEQ ID NO:21-41 and one mu opioid receptor binding moiety of SEQ ID NO:1-11.

Art Unit: 1647

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their recognized divergent subject matter as defined by MPEP § 808.02, the Examiner has *prima facie* shown a serious burden of search (see MPEP § 803). Therefore, an initial requirement of restriction for examination purposes as indicated is proper.

B. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 CFR § 1.48(b) and by the fee required under 37 CFR § 1.17 (h).

Advisory information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Landsman whose telephone number is (703) 306-3407. The examiner can normally be reached on Monday - Friday from 8:00 AM to 5:00 PM (Eastern time) and alternate Fridays from 8:00 AM to 5:00 PM (Eastern time).

If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Gary Kunz, can be reached on (703) 308-4623.

Official papers filed by fax should be directed to (703) 308-4242. Fax draft or informal communications with the examiner should be directed to (703) 308-0294.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Robert Landsman, Ph.D. Patent Examiner Group 1600 July 26, 2001

SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600